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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,344	02/24/2004	Kirk D. Swenson	3896-040075 (P-5973)	8737

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EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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06/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/785,344	Applicant(s) SWENSON, KIRK D.	
	Examiner DWAYNE K. HANDY	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-32 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-18 and 33-40 is/are rejected.
- 7) ☒ Claim(s) 4, 9 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, 5-8, 10-18 and 33-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,651,835. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 1-22 of the ‘835 patent recite embodiments of a container assembly that fully encompasses or is obvious over the rejected instant claims. See Paragraphs 6 and 7 below.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 5-7, 10-18 and 33-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iskra (US 2002/0011492).

6. The rationale for the Examiner's application of the Iskra reference(s) is as follows: Figure 4 of Iskra shows a collection container having a variety of paths through the textured area. The Examiner recognizes that Iskra has used the term "circuitous path" and the instant claim recites "longitudinal groove" in disclosing their respective venting pathways. The Examiner submits that the two terms are not exclusive and that the "circuitous paths" of Iskra anticipate the "longitudinal grooves" of claims 1 and its rejected dependent claims. That is, the term "longitudinal" does not require that the groove be straight.

When given its broadest interpretation, the term "longitudinal" simply means "placed or running lengthwise" (Merriam's Dictionary). The Examiner submits that this is what the passages "A" shown in Figure 4 do – they run the length of the textured area. The Examiner recognizes his duty to interpret the claims in light of the Specification and notes that Applicant has shown several embodiments in which the "longitudinal groove" is indeed a straight line. Applicant has not, however, specifically limited the "longitudinal groove" to a straight line in the Claims or in the Specification. In addition, claim 1 recites a venting pathway "comprised of a textured surface and a longitudinal groove for allowing air to vent...". Claim 33 recites first and second grooves passing through a textured surface on the inner tube. These limitations do not require that the longitudinal grooves are present **outside** the textured surface area. Therefore, the instant limitation of the "longitudinal groove" in claims 1 and 33 is anticipated by the circuitous path of Iskra simply by the fact that the path of Iskra runs through the textured material present on the inner tube's outer surface. In short summary, the Examiner

takes the position that the claim as written allows the groove to be within the textured surface and the term longitudinal does not limit the groove to a straight line. The pathways 'A' of Iskra meet this interpretation of the claim. This argument is the basis for the USC 102 rejection.

7. The Examiner additionally asserts that even if the Examiner were to interpret the claim such that "longitudinal" to mean "straight" then the claim would still be rejected under USC 103. The Examiner submits that since the circuitous path ('A') serves the same function as the groove (i.e. venting pathway), the portion of the longitudinal groove within the textured surface area is simply an obvious change in shape of the venting pathway of Iskra. See MPEP 2144.04, Section IV, B on Changes in Shape. This line of argument provides the rationale for the 103 portion of the rejection.

8. Finally, the Examiner notes that claims 4, 9 and 19 were not included in the Iskra rejection due to the explicit recitation of a portion of the longitudinal groove that is **outside** of the textured area. These claims have been objected to as allowable but dependent upon a rejected base claim.

9. Claims 8, 10 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iskra (2002/0011492). Iskra teaches every element of claims 8, 10 and 37-40 except for the textured surface on the inner side of the outer tube. The Examiner takes the position that placing the textured surface on the inner side of the

outer tube instead of the outer side of the inner tube is an obvious reversal of parts since the resulting assembly would have the venting pathways between the inner and outer surface as required by the claims. See MPEP 2144.04, Section VI, A on Reversal of Parts.

Allowable Subject Matter

10. Claims 20-32 are allowed. Claim 20 recites a container assembly having inner and outer containers. The outer container includes a first longitudinal groove and the inner container has a second longitudinal groove such that when the inner container is placed in the outer container the grooves align to allow air to vent from between the tubes through a venting pathway at the open top of the outer tube. Claim 28 recites a method of assembling the device of claim 20. The Examiner did not find prior art which teaches or suggests these features.

11. Claims 4, 9 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Iskra and Reichenbach show collection assemblies having vents comprised of a textured surface.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

/Dwayne K Handy/
Examiner, Art Unit 1797
June 22, 2008